

REMARKS

I. Introduction

Claims 1-4, 6-19, 21-27, 30-34, and 37-46 are pending in the current application. Claim 15 has been cancelled and claim 47 has been added by the present amendment. Thus claims 1-4, 6-14, 16-19, 21-27, 30-34, and 37-47 will remain pending after entry of the present amendment.

Claims 1-4, 6-19, 21-27, 30, 33, 34, 37-40 stand rejected under 35 U.S.C. § 102(b). Applicant notes with appreciation that claims 31 and 32 are indicated as containing allowable subject matter and would stand allowed if rewritten in independent form. The current Office Action does not reflect that claims 41-46 are pending and thus has not addressed those claims. Applicant traverses the current rejections and respectfully requests reconsideration and withdrawal of the rejections in light of the remarks and amendments contained herein.

Applicant has amended independent claim 1 to recite limitations substantially as set forth in claim 15. Accordingly, claim 15 has been cancelled. Claim 1 has been amended to recite that the data stream is provided by an application which has not been adapted to control the additional functions and that the data patterns in the data stream are native to the output of the application. Support for the foregoing subject matter appears in the specification at, *inter alia*, page 5, lines 18-26, page 10, lines 12-16, and page 12, lines 9-23. Claim 1 has further been amended to remove the limitation with respect to the at least one additional function further comprising accepting data from a source other than the data stream, and thus any distinctions previously made with respect to this limitation and claim 1 are no longer applicable. This limitation has been resubmitted in new claim 47 which is dependent from claim 1. Claim 12 has been amended to track the amended language of claim 1. Claims 16, 18, 19, 21, and 22 have been amended to depend from claim 1 rather than cancelled claim 15, and claims 19, 21, and 22 have further been amended to track the language of amended claim 1. The foregoing amendments do not introduce new subject matter.

Applicant has amended independent claim 33 to recite that the data stream is provided by an application which has not been adapted to control the additional printing operation. Support for the foregoing subject matter appears in the specification at, *inter alia*, page 5, lines 18-26, page 10, lines 12-16, and page 12, lines 9-23. Claim 33 has further been amended to clarify the language therein by deleting “therefrom” and inserting therefor “from said data stream.”

Claim 40, dependent from claim 33, has been amended to recite that the data patterns in the data stream are native to the output of the application. Support for the foregoing subject matter appears in the specification at, *inter alia*, page 5, lines 18-26, page 10, lines 12-16, and page 12, lines 9-23.

II. Rejections under 35 U.S.C. § 102(b)

Claims 1-4, 6-19, 21-27, 30, 33-34, and 37-40 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Harman et al., United States patent number 5,684,706 (hereinafter *Harman*). Applicant respectfully traverses the rejections of record.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Moreover, the Examiner has the burden of establishing a *prima facie* case of anticipation. *See In re Skinner*, 2 USPQ2d 1788, 1788-89 (B.P.A.I. 1986) (stating, “[i]t is by now well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office.”). *Harman*, as cited by Examiner, does not teach all the elements of the claims nor does *Harman* show the invention in as complete detail as the claims.

A. The Independent Claims

1. Claim 1

Claim 1, as amended, recites that the “data stream is provided by an application which has not been adapted to control said additional functions and said abstracting includes examining said data stream for data patterns native to output of said application” The rejection of record relies upon printer controller 58 of *Harman* as providing abstracting of a data stream, Office Action at page 3. However, printer controller 58 receives job data 10 for use in parsing operations provided thereby, see column 5, lines 37-38. Job data 10 is generated by driver 37 to include various job control aspects, see column 3, lines 25-29 and lines 51-65, column 4, lines 35-36, and column 5, lines 37-42. Although *Harman* teaches parsing of job data 10, there is nothing to teach printer controller 58 abstracting data bits from the data stream, wherein the abstracting includes examining the data stream for data patterns native to output of the application, see column 4, lines 32-41, and Figure 2, items 26-1 to 26-4. Accordingly, printer controller 58 cannot be read to abstract data bits from a data stream provided by an application which has not been adapted to control the additional functions.

Moreover, Applicant is unable to identify any portion of the system of *Harman* which can be read to meet the claim. For example, mail center controller 4 receives job data 10 which does not meet the recited data stream provided by an application which has not been adapted to control the additional functions. Moreover, mail center controller 4 does not appear to provide any functionality which may be read to meet the recited abstracting, but rather is taught to append postage to job data 10, column 10, lines 13-24.

Claim 1 recites “creating, from said abstracted data bits, a separate data stream for controlling the printing of said postage indicia.” Mail center controller 4 does not create a data stream separate from job data 10 and thus cannot be read to meet the claim. Similarly, driver 37 does not create a separate data stream for controlling the printing of postage indicia. Instead, driver 37 creates job data 10 which includes the document data input into driver 37 as well as

various job control aspects appended thereto, column 4, lines 12-14. Accordingly, Applicant respectfully asserts that *Harman* cannot be read to anticipate the claim under 35 U.S.C. § 102.

2. Claim 17

Claim 17 recites “wherein said abstracting includes examining said data stream for preestablished data patterns, and wherein said preestablished data patterns include the beginning and ending of postage indicia data.” The rejection of record is unclear as to what aspect of *Harman* is being relied upon to meet the foregoing limitations, Office Action at page 6. However, it appears that the rejection relies upon unique separators 26-1, 26-2, 26-3, and 26-4 as the foregoing are the only data demarcations mentioned in the cited portions of *Harman*. However, the unique separators do not anticipate the recited beginning and ending of postage indicia data. The postage values for each mail piece of *Harman* are taught to be placed in a field in header 18, see column 5, lines 21-24. Although unique separator 26-1 appears to delineate the end of a header, it is not taught to be an ending of postage indicia data. Moreover, there is nothing shown to meet the beginning of postage indicia data. As such, *Harman* has not been shown to anticipate the claim under 35 U.S.C. § 102.

3. Claim 23

Claim 23 recites “calculating under joint control of said secure memory and said separate data stream an amount of postage to be applied to a particular document to be printed” The Examiner cites to *Harman* column 6, lines 1-7 as teaching this limitation of claim 23, Office Action at page 7. The identified portion of *Harman* teaches the calculation of postage by mail center controller 4. However, in *Harman*, the mail center controller does this calculation prior to the parsing which the Examiner relies upon as the creation of a separate data stream. Because the cited postage calculation in *Harman* is done before the creation of the separate data stream, it is not possible for the separate data stream in *Harman* to control calculating the amount of postage. In other words, in *Harman*, there is no separate data stream in existence at the point postage is calculate in *Harman*. Thus, the Examiner has not shown *Harman* teaches calculating

under joint control of said secure memory and said separate data stream an amount of postage to be applied to a particular document to be printed as required by claim 23.

Moreover, claim 23 recites “deducting said calculated postage amount from said secure memory” The Examiner cites Figure 6B of *Harman* in rejecting this aspect of the claim. However, Figure 6B merely shows charging a selected account for postage when a job is successfully completed, see column 10, lines 22-25. This disclosure is not sufficient to anticipate the claim limitation requiring that the calculated postage amount is deducted from a secure memory used in calculating the amount of postage to be printed.

4. Claim 33

Claim 33, as amended, recites “an abstracting program operable for reviewing said data stream to obtain from said data stream a separate data stream for controlling additional printing operations ancillary to said printing operation . . . wherein said data stream is provided by an application which has not been adapted to control said additional printing operations” The rejection of record relies upon printer controller 58 of *Harman* as providing abstracting of a data stream, Office Action at page 9. However, as discussed above with respect to claim 1, printer controller 58 receives job data 10 for use in parsing operations provided thereby, see column 5, lines 37-38. Job data 10 is not provided by an application which has not been adapted to control said additional printing operations. Accordingly, printer controller 58 cannot be read to meet the abstracting program operable for reviewing the data stream to obtain a separate data stream, wherein the data stream is provided by an application which has not been adapted to control the additional printing operation.

Moreover, as discussed above with reference to claim 1, Applicant is unable to identify any portion of the system of *Harman* which can be read to meet the claim. For example, mail center controller 4 receives job data 10 which does not meet the recited data stream provided by an application which has not been adapted to control the additional functions. Moreover, mail

center controller 4 does not appear to provide any functionality which may be read to meet the recited abstracting, but rather is taught to append postage to job data 10, column 10, lines 13-24.

Claim 33 recites “obtain[ing] from said data stream a separate data stream for controlling additional printing operations” Mail center controller 4 does not create a data stream separate from job data 10 and thus cannot be read to meet the claim. Similarly, driver 37 does not create a separate data stream for controlling the printing of postage indicia. Instead, driver 37 creates job data 10 which includes the document data input into driver 37 as well as various job control aspects appended thereto, column 4, lines 12-14. Accordingly, Applicant respectfully asserts that *Harman* cannot be read to anticipate the claim under 35 U.S.C. § 102.

B. The Dependent Claims

Claims 2-4, 6-14, 16, 18, 19, 21, 22, and 47 depend directly or indirectly from claim 1. Claims 24-27 and 30-32 depend directly or indirectly from claim 23. Claims 34 and 37-40 depend directly or indirectly from claim 33. As discussed above, *Harman* does not teach all the limitations of claims 1, 23, and 33. Each dependent claim inherits the limitations of its respective base claim and for at least this reason dependent claims 2-4, 6-14, 16, 18, 19, 21, 22, 24-27, 30-32, 34, 37-40, and 47 are patentable. Moreover, the dependent claims recite additional new and non-obvious limitations.

For example, claim 4 recites, “at least one additional function further comprises a dialog box for allowing options from a user.” The Examiner cites to column 4, lines 36-41 for this limitation of claim 4, Office Action at page 3. Nowhere in the identified portion of *Harman*, however, is there any teaching of a dialog box. The citation merely teaches the data flow in an input station such as a microcomputer where a word processing document is used. The Examiner has not shown therefore that *Harman* teaches an additional function comprises a dialog box for allowing options from a user as required in claim 4.

Claim 6 recites at least one additional function further comprises directing the abstracted portion to multiple locations. The Examiner cites to column 5, lines 36-41 as teaching this limitation of claim 6, Office Action at page 3. In the identified portion of *Harman*, however, there is no teaching that abstracted data bits controls directing the abstracted portion to multiple locations. In fact, the citation specifically teaches, sending the attribute data to mail finishing unit controller 100, and sending document data 20 to the document printer engine. In other words, neither parsed data stream, described in the citation to *Harman*, is sent to multiple locations. Thus the Examiner has not shown *Harman* teaches at least one additional function further comprises directing the abstracted portion to multiple locations as recited in claim 6.

Claim 11 recites at least one additional function further comprises the change in at least one of location and format of the data based upon an interaction between certain data in said data stream and data stored in said printer driver. The Examiner cites to *Harman* column 5, lines 37-40 for this limitation of claim 11, Office Action at page 4. The identified portion of *Harman* teaches the printer controller receives the job data and parses it; sending the attribute data to the mail finishing unit controller and sending document data to document printer engine. However, *Harman* does not teach that data stored in the printer driver interacts with data in the data stream to change the location and/or format of the data. The Examiner, therefore, has not shown *Harman* teaches all the limitations of claim 11.

Claim 21 requires that the abstracting of data bits includes examining the data stream for data patterns including the beginning and ending of each document. The Examiner relies on *Harman*, column 4, lines 18-20, to meet the foregoing, Office Action at page 7. The cited portion of *Harman*, however, does not teach that there is abstracting that includes examination of the data stream for the beginning and ending of each document to be printed. Rather, the identified portion of *Harman* teaches that document data defines a sequence of document pages to be printed by the document printer. Therefore, the Examiner has not shown *Harman* teaches all the limitations of claim 21.

Claim 22 recites “wherein said data patterns include the number of pages of a document.” The Examiner cites to column 3, lines 57-60, of *Harman* as teaching the limitation of claim 22, Office Action at page 7. However, the identified portion of *Harman* does not teach that the abstracting of data bits includes examining the data stream for the number of pages of a document. Therefore, the Examiner has not shown that *Harman* teaches all the limitations of claim 22.

In rejecting claim 25, the Examiner relies upon *Harman* column 5, lines 42-45, as teaching copying from the data stream portions of the data stream, Office Action at page 8. The identified portion of *Harman* however teaches the mail finishing unit controller stores mail piece attributes and downloads common elements of the address to be printed. Assuming, *arguendo*, that this is copying, the teaching is that the data stream sent to the mail finishing unit is the parsed attribute data. Thus, the mail finishing unit could only copy the parsed attribute data and has no opportunity to copy the data stream. Therefore, the Examiner has not shown *Harman* teaches copying from said data stream portions of said data stream, as required by claim 25.

Claim 26 requires copying portions of said data stream including address information with respect to a particular document to be printed. The Examiner cites to *Harman* column 5, lines 42-45, as teaching this limitation of claim 26, Office Action at page 8. However, as discussed above, this citation teaches that the asserted copying occurs from the parsed attribute data and not the data stream. Thus the Examiner has not shown *Harman* teaches the limitations of claim 26.

Claim 27 requires creating, from the copied address information, a postage indicia. The Examiner cites to *Harman* column 6, lines 9-15, as teaching this limitation of claim 27, Office Action at page 8. In the cited portion of *Harman*, however, the controller downloads the address to the printer and the printer then franks the mail piece with postage indicia. There is no teaching here that the postage indicia is created from copied address information. In fact, as discussed above, the Examiner has not shown that there is any information copied from the data

stream. Thus, the Examiner has not shown *Harman* teaches creating, from the copied address information, a postage indicia as required by claim 27.

Claim 38 requires that the computer product is located remote from the computing device. The Examiner cites to Figure 1 of *Harman* to meet the claim, Office Action at page 10. However, Applicant respectfully points out that the rejection of record does not explain how Figure 1 teaches the limitations of claim 38, nor is it obvious from Applicant's review of the figure. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. M.P.E.P. § 706. Accordingly, the Examiner has not shown that *Harman* teaches the limitations of claim 38.

Claim 39 recites that the computer product is located within the printer. The Examiner cites to column 5, lines 28-31, of *Harman* as teaching the limitations of claim 39, Office Action at page 10. However, the cited portion of *Harman* only teaches that *Harman* uses a laser printer. There is no teaching in the cited portions of *Harman* that the laser printer has a computer product as recited in claim 39 located therein. The Examiner, therefore, has not shown *Harman* teaches the limitations of claim 39.

Claim 40, as amended, recites "a control program for examining said data stream for certain preestablished data patterns, wherein said control program examines said data stream for data patterns native to output of said application." Applicant respectfully asserts that *Harman* does not teach a control program meeting that of claim 40.

III. The Unaddressed Claims

The disposition of claims 41-46 is not provided in the current Office Action in both the Office Action Summary and in the Detailed Action. "In every Office action, each pending claim should be mentioned by number, and its treatment or status given." M.P.E.P. § 707.07(i). Because claims 41-46 are not mentioned in the Office Action, Applicant does not know the current U.S.P.T.O. position with regard to these claims. Applicant believes the claims are in

condition for allowance. If the Examiner does not agree that these claims are in condition for allowance, a subsequent Office Action rejecting claims 41-46 must not be made final.

IV. Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 61135/P016US/10106022 from which the undersigned is authorized to draw.

Dated: April 16, 2007

Respectfully submitted,

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is e-filed on the date shown below.

Dated: April 16, 2007

Signature: _____

(Joy Perigo)

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